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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,149	07/21/2003	Antonie Neubauer	1/1372	5659

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EXAMINER

SALIMI, ALI REZA

ART UNIT PAPER NUMBER

1648

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/624,149

Applicant(s)

NEUBAUER ET AL.

Examiner

A R. Salimi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 3, and 13-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

This is a response to the amendment filed 2/2/06. Claims 1-31 are pending. Claims 3, 13-31 have been withdrawn for reasons of record. Claims 1, 2, and 4-12 are under active consideration.

**Applicants are reminded to cancel the claims to the non-elected Group(s).**

Please note any ground of rejection that has not been repeated is removed.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 102***

Claims 1, 2, 4-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Osterrider et al (Journal of Virology, 1996, Vol. 70, No. 6, pages 4110-4115) for reasons of record advanced in the previous Office Action mailed 8/4/2005. Applicants argue that the claim 1 is directed to an equine herpesvirus wherein gM is absent and wherein said EHV is free of heterologous elements. Therefore, the teaching of Osterrider et al does not anticipate. Applicant's argument as part of amendment filed 2/2/06 has been considered fully, but they are not persuasive. The product disclosed in the above cited reference is identical to the product claimed by the Applicants. Moreover, if the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Moreover, applicants are directed to *In re Cruciferous*

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Sprout Litigation, 64 USPQ2d 1202 (CA FC 2002) wherein the Federal Circuit cited authority for the rule that, "a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it." The court said, "While Brassica may have recognized something quite interesting, it simply has not invented anything new." This is the case here, while the Applicants may have "Observed" something interesting they have not invented anything new. The product disclosed is the same and inherently performs the same function. The rejection is maintained.

***Claim Rejections - 35 USC § 102***

Claims 1, 2, 4-11 are rejected under 35 U.S.C. 102(a) as being anticipated by Elbers et al (EP 1,129,722 A1, 9/5/2001) for reasons of record advanced in the previous Office Action mailed 8/4/2005. Applicants argue the gM negative mutant of Elbers et al comprises of heterologous sequences in the form of E. coli lacZ gene. Applicants conclude, therefore, the product of claim 1 is not the same as disclosed by Elbers et al. The test is whether the product disclosed in the prior art can perform the same function as now claimed product. The answer is clearly, yes. The marker gene in place of gM gene as taught by Elbers et al was to show the capacity of the virus to remain function absent the deleted gM gene. The product of claim 1 is the same virus which is deleted for gM gene, same as Elbers' et al product. The product disclosed is the same and inherently performs the same function. Moreover, if the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The rejection is maintained.

***Claim Rejections - 35 USC § 102***

Claims 1, 2, 4-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Elbers et al (US Patent No. 6,703,231) for reasons of record advanced in the previous Office Action mailed 8/4/2005. Applicants argue the gM negative mutant of Elbers et al comprises of heterologous sequences in the form of E. coli lacZ gene. Applicants conclude, therefore, the product of claim 1 is not the same as disclosed by Elbers et al. The test is whether the product disclosed in the prior art can perform the same function as now claimed product. The answer is clearly, yes. The marker gene in place of gM gene as taught by Elbers et al was to show the capacity of the virus to remain function absent the deleted gM gene. The product of claim 1 is the same virus which is deleted for gM gene, same as Elbers' et al product. The product disclosed is the same and inherently performs the same function. Moreover, if the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The rejection is maintained.

No claims are allowed.

***Allowable Subject Matter***

Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. R. Salimi whose telephone number is (571) 272-0909. The examiner can normally be reached on Monday-Friday from 9:00 Am to 6:00 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (571) 272-0902. The Official fax number is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A. R. Salimi

03/02/2006

ALI R. SALIMI  
PRIMARY EXAMINER